IN THE UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS

ARIBA, INC., a Delaware corporation, Plaintiff, v. EMPTORIS, INC., a Delaware corporation, Defendant.	C.A. No. 9:07-CV-90 (RC)

JOINT SUBMISSION REGARDING EMPTORIS, INC.'S PROPOSED SUPPLEMENTAL JURY INSTRUCTION

Emptoris wishes to submit to the jury an instruction regarding the material that may be considered by the Patent and Trademark office in the context of *ex parte* patent reexamination proceedings. Ariba objects to the submission of such an instruction as irrelevant to this case, given that Emptoris had the opportunity to present to the PTO every piece of prior art that it has or will present at trial. Ariba submits that Emptoris's proposed instruction, as written, is incorrect as a matter of law, and specifically is inconsistent with the Manual of Patent Examining Procedure, section 2205. Ariba believes this instruction is unnecessary and cumulative to instructions that the jury has and will receive about its role on the issue of validity. If the court decides that some instruction is appropriate, however, Ariba submits that Emptoris's proposed instruction should be amended to include the underlined language below and exclude the **bolded** language below.

MATERIAL THAT MAY BE CONSIDERED BY THE PATENT AND TRADE OFFICE

You have heard evidence that both of the patents in suit were submitted to the patent office for what is called a re-examination. This is a process by which non-inventors may challenge the validity of a patent. You may consider this patent office proceeding in making your determination about the validity of the patents in this case, and whether Emptoris willfully infringed those patents -- but keep in mind that you, not the patent office, will make the final determination on **this issue** these issues.

To assist you in your consideration of the re-examination proceedings, I want to briefly explain that process to you. In a re-examination proceeding, the patent office may **only** consider patents and printed publications -- along with explanations of contents of those patents and printed publications, including in the form of affidavits, declarations, or inventor deposition testimony -- as evidence of prior art. In the reexamination proceedings commenced by Emptoris relating to the '114 and '018 patents, Emptoris had the opportunity to submit to the patent office any and all patents and publications it believed were relevant to the validity of the '114 and '018 patents.

While the patent office may consider testimony relating to publications submitted on reexamination, it **The patent office** may not consider testimony or prior inventions unrelated to any **not in** patents or publications as evidence of prior art. **You, however, are not bound by the same rules as the patent office.** You may consider all the evidence you have heard here at trial -- including the testimony you have heard both from live witnesses and witnesses who testified by deposition -- in making your determination as to whether the patents are invalid. You should not, however, credit testimony from purported inventors if such testimony is not specifically corroborated by documentary evidence.

AUTHORITY

35 U.S.C. §§ 301, 302; Manual of Patent Examining Procedure § 2205.

Dated: October 26, 2008

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Stephen M. Muller, hereby certify that a copy of the foregoing was served via electronic filing this 26th day of October, 2008 upon Robert T. Haslam, Covington & Burling LLP, 333 Twin Dolphin Drive, Suite 700, Redwood Shares, CA 94065-1418 and Carl R. Roth, The Roth Law Firm, P.C., 115 North Wellington, Suite 200, Marshall, TX 75670.

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